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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,590	10/08/1999	K. Scott Ramey	03384.0374	3561
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2154

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/414,590

Applicant(s)

RAMEY ET AL.

Examiner

Larry D. Donaghue

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 76-85 is/are allowed.
- 6) ☒ Claim(s) 86-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. Claims 67-90 are presented for examination.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 67-90 provisionally rejected under the judicially created doctrine of double patenting over claims of copending Application No. 10/662,603 and . This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Claim(s) 67 and 68 of the instant application contain(s) every element of claim(s) 35 of the co-pending application and as such anticipate(s) claim(s) 35 of the co-pending application 10/622,603.

Claim(s) 67 and 71 of the instant application contain(s) every element of claim(s) 64 of the co-pending application and as such anticipate(s) claim(s) 64 of the co-pending application 10/808,092.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a

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patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 86-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood WO 98/18283 in view of the Java Telephony API: An Overview, version 1.1, pp. 1-41, January 28, 1997, hereinafter the "Java Telephony API."

6. The Wood WO 98/18283 reference was cited in paper 8.

Regarding claim 86, Wood teaches the invention substantially as claimed by disclosing a system comprising: A web application for independently controlling a legacy call server coupled to the telephone system (Fig. 1 elem. 22 web facility as web application; Fig. 1 elem. 16 as legacy call server); a call server wrapper having a first web application program interface and a call server system interface for enabling the web application to communicate with the legacy call server (Fig. 1 elem. 38 CGI scripts controlling call control system as call server wrapper).

Wood does not explicitly teach using the web application to control the legacy telephone and a telephony device wrapper having a second web application program interface and a telephony device interface for enabling the web application to communicate with the legacy telephony device.

The Java Telephony API on the other hand teaches using the web application to control a legacy telephone and a telephony device wrapper having a second web application program interface and a telephony device interface for enabling the web application to communicate with the legacy telephony device (p. 1 implementation of 1 JTAPI on top of proprietary hardware; p. 8 terminal object; p. 25 java.telephony.phone package; pp. 27-41 showing various functions of the phone controlled by the java.telephony.phone API).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Java Telephony API's teachings regarding the control of a telephone terminal with the system of Wood based on Wood's explicit suggestion to use the Java Telephony Toolkit (Page 5, lines 1-6).

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Wood does not explicitly teach using the web application to control the legacy telephone and a telephony device wrapper having a second web application program interface and a telephony device interface for enabling the web application to communicate with the legacy telephony device.

The Java Telephony API on the other hand teaches using the web application to control a legacy telephone and a telephony device wrapper having a second web application program interface and a telephony device interface for enabling the web application to communicate with the legacy telephony device (p. 1 implementation of 1 JTAPI on top of proprietary hardware; p. 8 terminal object; p. 25 java.telephony.phone package; pp. 27-41 showing various functions of the phone controlled by the java.telephony.phone API).

Regarding claim 89, Wood teaches the invention substantially as claimed by disclosing a system comprising: A digital computer containing a communication circuit for enabling a legacy call server to communicate with a web application (Fig. 1 elem. 22 web facility; more specifically Fig. 2 elems. 30 and 32); A circuit for using the web application to control the legacy call server (Fig. 1 elem. 22 web facility; more specifically Fig. 2 elems. 30 and 32); A circuit for enabling a legacy telephone device to communicate with the web application (Fig. 1 elems. 26 SCI and 16 telephone switch; page 8, lines 6-17).

Wood does not explicitly teach using the web application to control the legacy telephone and a telephony device wrapper having a second web application program interface and a telephony device interface for enabling the web application to communicate with the legacy telephony device.

The Java Telephony API on the other hand teaches using the web application to control a legacy telephone and a telephony device wrapper having a second web application program interface and a telephony device interface for enabling the web application to communicate with the legacy telephony.

As to claims 86 and 87, they are the corresponding method and means plus function claims to the apparatus claim of 89, and are rejected for similar rational.

As to claim 90, it is unpatentable over the combination of Wood in view of the Java Telephony API for the reasons given above with respect to claim 89. As to the addition of the call server wrapper, it is noted that the specification defines it as a program that enables a legacy call server to communicate with a web application. This feature corresponds to the software on the remote telephony server of figure 1 that handles method calls from the Provider object described on page 7 of the Java Telephony API. As to the telephony device wrapper, it is noted that the specification defines a telephony device wrapper as a program that enables a legacy telephony device to communicate with a web application. This feature corresponds to the software on the remote telephony server of figure 1 that handles method calls from the terminal object described on page 8 of the Java Telephony API.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D. Donaghue whose telephone number is 571-272-3962. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


LARRY B. DONAGHUE
PRIMARY EXAMINER